

### Remarks

Claims 1-15 are pending in the above-identified application. Claims 1, 7, and 12 are amended, claims 6, 10 and 15 are cancelled, and claims 2-5, 8, 9, 11, 13 and 14 are original.

The Examiner rejected the present claims under 35 U.S.C. 103(a).

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 provides: The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

One court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Id. at 1357, 47 USPQ2d at 1458. Here, according to this court, the Board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.

The Examiner made the following rejections:

Claims 1-4, 7-8, & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotzin [US 20040198360] in view of Rosenberg [US 20020102973].

Claims 5, 9, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotzin & Rosenberg further in view of Nelson [US 6470182].

Claims 6 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotzin & Rosenberg further in view of Moore [US 20050020293].

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kotzin & Rosenberg, Nelson further in view of Moore.

With regard to Applicant's previous claim amendments, the Examiner held that Applicant's arguments with respect to claims 1 - 15 has been fully considered but is moot in view of the new ground(s) of rejection.

With this amendment Applicant has combined the features of dependent claim 6 with independent claim 1, the features of dependent claim 10 with independent claim 7, and the features of dependent claim 15 with independent claim 12.

Applicant believes that any combination of the prior art references of Kotzin, Rosenberg, and Moore does not result in the claimed invention as set forth in the amended independent claims.

Kotzin teaches selection of a service provider network at a wireless subscriber device (10) that includes monitoring service provider network parameters (54) of each of a plurality of available service provider networks (S1, S2), predicting performance capabilities of each of the plurality of available service provider networks (S1, S2), computing a performance metric (56) for each of the plurality of available service provider networks (S1, S2) based on desired performance parameters and on the predicting of performance capabilities of each of the plurality of available service provider networks (S1, S2), and selecting one of the plurality of available service provider networks (S1, S2) based on the computed performance metric (58). The subscriber device (10) is therefore capable of rapidly and autonomously identifying a service provider network that would best serve its current service needs based on the performance metric.

Rosenberg teaches an intelligent roaming method that enables a mobile station (68) to select a preferred neutral service provider from a plurality of service providers within a communication system. The mobile station (68) identifies (S.4) a current communication system servicing a geographic area where the mobile station (68) is presently located. The mobile station (68) determines that the current communication system identified is not serviced by a home service provider (S.6) or by a preferred service provider (S.12) having a roaming agreement with the home service provider. Upon not finding home or preferred service, the mobile station (68) determines whether or not it is programmed for full service priority (S. 16.2). If the mobile

station (68) is programmed for full service priority, then mobile station (68) selects (S.16.8) the current communication system as the preferred neutral service provider (S.16.7) only when a frequency band of the current communication system corresponds to a first frequency band of frequency bands listed in priority order in a system access list (SAL) (S.16.4) stored in the mobile station (68) to permit the mobile station (68) to obtain full service (i.e., make and receive calls per roaming agreement) from the current communication system. Alternatively, the mobile station (68) selects (S.16.6) the current communication system as a foreign service provider (S.16.5) when the frequency band of the current communication system does not correspond to the first frequency band of frequency bands listed in priority order in the SAL to permit the mobile station (68) to obtain emergency service (i.e., only make "911" calls and not receive calls) from the current communication system. If the mobile station (68) is not programmed for full service priority, then mobile station selects (S.16.3) the current communication system as a neutral service provider to permit the mobile station (68) to obtain limited service (i.e., only make credit card calls and not receive calls) from the current communication system.

Moore teaches a method for re-selecting control channels in a mobile station reduces the use of resources by limiting an evaluation of candidate control channels to those channels which satisfy certain criteria and are deemed to be eligible control channels. As a consequence, resources are not spent on attempting to re-select a control channel that is not compatible with the mobile station.

The Examiner has cited Moore as teaching the claimed feature of re-selecting a respective roaming service provider for each subsequent call associated with the mobile terminal.

However, Moore teaches in paragraph [0008]: “ In accordance with the present invention a mobile station performs a method for controlling the re-selection of a control channel. In that method the mobile stations prior to performing any algorithm for selecting a primary candidate control channel, marks as ineligible, any one of the control channels identified on the neighbor list which are incompatible with the mobile station. The selection of a primary control channel then proceeds only with regard to those control channels which are determined to be eligible. Once a primary candidate control channel is selected the mobile station attempts to re-select to that primary candidate control channel. If the attempt to re-select is successful, then the mobile station camps on to this control channel. If, however, the attempt fails, then the mobile station determines why the attempt failed. If the failure arises from an incompatibility between the mobile station and the control channel, then that control channel is marked as ineligible in the neighbor list and when the re-selection process is repeated with the same neighbor list, since that control channel has been marked as ineligible it will not be a factor in the selection of a primary candidate control channel.”

Moore also teaches in paragraph [0020]: “As has been described above, a candidate channel could be ineligible because the control channel is associated with a private system, whereas the mobile station is not affiliated with any private system. Furthermore, a control channel may be deemed ineligible because of the type of service that it provides and the lack of compatibility between that service and the service of the mobile station. The predetermined criteria referred to in connection with Step 309 can be any condition that causes the failure of a reselect attempt. Typically one such event would be where the primary candidate channel is associated with a private system and the mobile station is also associated with a private system.

In that circumstance, then, the primary candidate channel would not then be marked ineligible in Step 303. Then, during the reselect attempt the private system identifier associated with the primary candidate channel would be provided to the mobile station. If the mobile station private system identifier stored in memory does not match the private system ID received from the primary candidate channel during the attempt to re-select, then the mobile station will not get access to the private system associated with that primary candidate channel. Therefore, there is an incompatibility between the mobile station and the system associated with that primary candidate channel. In view of this incompatibility, it is consistent with the present invention to now mark this primary control channel as ineligible as in step 310. Then, if it is necessary to analyze the neighbor list again (step 304) to find a candidate channel for re-selection, the newly designated ineligible control channel will not be analyzed."

The Examiner cited in Moore paragraph [0021]: "In accordance with the present invention, other parameter information associated with a control channel could be used to determine whether the control channel is eligible for re-selection by this particular mobile station. Furthermore, modifications to the process of FIG. 3 are also possible. For instance, in one variation Steps 301, 302 and 303 would be eliminated, that is the processor would not do any preliminary examination of the neighbor list to determine if any candidate channels are ineligible. Instead, the system would simply rely on marking primary candidate channels as ineligible for subsequent reselection attempts. Alternatively, the control method of the present invention could rely simply on the ineligibility determination made at the beginning of the analysis process and not dynamically evaluate ineligibility based on whether an attempt to reselect a particular

candidate channel was successful. Thus steps 309 and 310 could be eliminated and benefits would still be obtained from the remaining process."

It is clear that Moore teaches re-selecting based on marking different channels as ineligible and the keeping of a neighborhood list. Although Moore teaches re-selecting, Moore is silent with respect to re-selecting for each subsequent call. Moore clearly teaches camping out on a channel once the selection is made.

Therefore, no combination of the cited prior art results in the claimed invention as set forth in the amended claims.

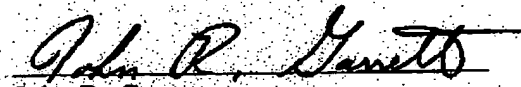
Since the dependent claims include all the limitations of the respective independent claims upon which they depend, the dependent claims are therefore also allowable over the cited prior art for the reasons set forth above with respect to the independent claims.

Applicants respectfully submit that the applied references, taken singly or in combination, assuming, arguendo, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Reconsideration and withdrawal of the rejections is therefore respectfully requested. In view of the above remarks, allowance of all claims pending is respectfully requested.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicant's attorney.

Respectfully submitted,



John R. Garrett  
Attorney for Applicant  
Reg. No. 27,888

Dated: May 30, 2006

CARMEN B. PATTI & ASSOCIATES, LLC  
Customer Number 47382